

REMARKS

This paper is being presented in response to the non-final official action dated April 6, 2006, wherein: (a) claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 were pending; and, (b) claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 were rejected under 35 USC § 103(a) as obvious over Ginter et al. U.S. Patent No. 5,892,900 ("Ginter") in view of Popolo et al. U.S. Patent No. 5,715,402 ("Popolo"). Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the second month, and payment of the required extension fee.

I. The 35 USC § 103(a) Rejection Is Traversed

Claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 were rejected as obvious over Ginter in view of Popolo. See pp. 2-17 of the action. Reconsideration is requested.

A. Proper Basis for a § 103(a) Rejection

To establish a *prima facie* case of obviousness, the PTO must satisfy three basic criteria. First, the combined disclosure of the prior art references must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation to modify or combine the teachings in the art to make the precise combination recited in the claims. Finally, a person having ordinary skill in the art must have a reasonable expectation of success when combining or modifying the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be derived from the prior art, and not from the application's disclosure. See MPEP §§ 2142-43 (8th ed., October 2005).

B. Disclosures of Ginter and Popolo

Ginter discloses methods and systems for secure transaction management and electronic rights protection. The methods are generally directed to electronic security. More specifically, a virtual distribution environment (VDE) is disclosed that controls, meters, and/or monitors the use of electronically stored or disseminated information. See, e.g., Ginter at abstract.

Popolo discloses a method and a system for matching sellers and buyers of spot metals such as steel. The disclosed method is particularly directed toward the secondary steel market. In the disclosed method, sellers post metal item lots for sale and buyers are able to search and bid on posted items. See, e.g., Popolo at abstract.

C. Ginter and Popolo Fail to Teach or Suggest Price Transparency or Weighted Average Price Indices

Claims 10, 26, and 34 recite "transmitting metal exchange transaction information to a plurality of registered users to provide price transparency, the metal exchange transaction information including a plurality of metal lot records, each metal lot record including a lot type, a lot quantity, a lot price, and an exchange date." Claim 49 recites analogous features related to price transparency.

Claims 18 and 34 recite "providing a weighted average price index based on the plurality of exchanges."

Ginter is concerned with neither price transparency nor price indices that can be computed using price-transparent transaction data. To the contrary, Ginter is concerned restricting access to information, price or otherwise:

This invention also relates to computer-based and other electronic appliance-based technologies that help to ensure that information is accessed and/or otherwise used only in authorized ways, and maintains the integrity, availability, and/or confidentiality of such information and processes related to such use.

Ginter, col. 1, lines 10-15. Ginter discloses the use of historical transaction data only in the limited roles of, for example, allowing a single end-user of the system to review his own prior transactions or allowing a digital content provider to review its own prior transactions to implement pricing and/or content control strategies. See, e.g., Ginter at col. 24, lines 24-53 and col. 26, lines 40-45. Ginter nowhere mentions the term "index" in the context of a price index based on a plurality of exchanges between a plurality of sellers and a plurality of buyers.

Popolo also does not teach or suggest price transparency or price indices as recited in the claims. Popolo's system does not provide information related to completed exchanges; rather, it provides information related to open bids. See, e.g., Popolo, col. 11 ("Panel #1 – Items Posted for Sale") and col. 13 ("Panel #2 – Bids on Item XXXXX"). Popolo's system cannot provide completed exchange data because transactions are concluded outside the system:

If [the seller accepts the buyer's bid], the buyer and seller can arrange the physical movement of money and steel either off-line or through electronic mail communications.

Popolo, col. 12, lines 16-19. Further, once a sale has been completed, the system only retains information regarding the bid item for a short time, and there is no indication that system provides metal exchange transaction information such as final lot price or exchange date for the sale. See Popolo, col. 15, lines 21-24 and Panel #3. Additionally, because

Popolo's system does not retain cumulative historical metal exchange transaction information, it is incapable of providing a weighted average price index.

Thus, even if properly combinable, Ginter and Popolo do not teach or suggest the price transparency feature (recited in claims 10, 26, 34, and 49) or the price index feature (recited in claims 18 and 34).

D. Ginter and Popolo Fail to Teach or Suggest FAS133 Compliant Derivative Contracts

Claims 1 and 19 recite "transmitting a purchase selection to the metal buyer for a FAS133 compliant derivative contract."

The official action does not assert that either of Ginter or Popolo discloses a FAS133 compliant contract; rather, it asserts that such a contract represents nonfunctional data that would be obvious to the skilled artisan. See p. 6 of the action.

Nonfunctional data is that which cannot exhibit any functional relationship with the way in which a computing process is performed. See MPEP § 2106(IV)(B)(1)(b). A FAS133 compliant derivative contract must be based on a metal-specific, accurate price index computed from past transactions. See p. 2, lines 1-13 of the specification. Thus, in the context of claims 1 and 19, a FAS133 compliant contract is functionally related to the receiving of metal identification information (i.e., information such as metal type, weight, price, and, optionally, chemistry, which information is used to create a price index), and it is not simply an arbitrary form of contract.

Further, a FAS133 compliant derivative contract is not taught or suggested by Ginter and Popolo. When Ginter refers to a "contract," it does so either in the general sense or in the specific context of a contract controlling access to electronic content. For example:

An electronic contract is an electronic form of an agreement including rights, restrictions, and obligations of the parties to the agreement. In many cases, electronic agreements may surround the use of digitally provided content; for example, a license to view a digitally distributed movie.

Ginter, col. 269, lines 17-21. While Ginter indicates that agreements within the scope of its disclosure need not necessarily relate to the control of electronic content (see Ginter, col. 269, lines 22-24), it provides no guidance as to any particular broader application. See, e.g., Ginter at col. 272, line 62-65 and Fig. 75E (describing an electronic contract only broadly as a collection of "clauses" and "signatures"). Similarly, Popolo is concerned with spot metal sales (i.e., sales for immediate delivery), and thus does not suggest application of its method to derivative contract sales.

Also, because the combination of Ginter and Popolo does not teach or suggest the features of price transparency or a weighted average price index (see Section I.C above), the

combination cannot provide the information necessary to support a FAS133 compliant derivative contract in the first instance.

Thus, even if properly combinable, Ginter and Popolo do not teach or suggest the FAS133 compliant derivative contract feature recited in claims 1 and 19.

E. Ginter and Popolo Fail to Teach or Suggest Metal Chemistry Composition Information in the Recited Detail

Claim 21 recites that transmitting a metal chemistry composition includes “transmitting a percentage of one of silicon, copper, magnesium, nickel, tin, lead, iron, manganese, chromium, zinc, and titanium.”

Claim 22 recites that transmitting a metal chemistry composition includes “transmitting a percentage of two of silicon, copper, magnesium, nickel, tin, lead, iron, manganese, chromium, zinc, and titanium.”

Claims 23 and 34 recite transmitting (claim 23) or receiving (claim 34) “a range for each of a plurality of elements from the periodic table of elements” when transmitting / receiving a metal chemistry composition.

Claim 35 recites “processing an exchange of a platinum group metal.”

The official action acknowledges that Ginter does not relate to the buying and selling of metals. See p. 3 of the action.

Popolo does not disclose the use of metal chemistry composition information in the detail recited in the present claims. Specifically, Popolo does not disclose the use of a composition percentage of a particular element or the use of a composition range for a plurality of elements. Popolo discloses a chemistry field whose information is provided by the buyer. See Popolo, col. 5, line 46. However, this field is limited to *generic* metal classifications (e.g., “SAE/AISI 1006, UNS G10060”), and Popolo does not disclose that actual elemental component identities, concentrations (i.e., percentages), or concentration ranges are stored in this field. See Popolo, col. 7, lines 17-32. Also, Popolo makes no reference to platinum-group metals (Ru, Rh, Pd, Os, Ir, and Pt).

Additionally, while Popolo discloses its method with respect to spot metals in general, it is clearly focused on the secondary steel market. See Popolo, at col. 1, lines 14-17. Therefore, there is no desirability for an extensive per-element compositional description of the metal lots, because the limited class of steel (i.e., as compared to the more general class of an arbitrary metal alloy) can be simply classified with a single name/product identification code. See, e.g., Popolo at col. 7, lines 17-32 (providing a list of different steel classifications as possible field chemistry values). In the context of Popolo, the skilled person is not motivated to select an unnecessarily complicated (i.e., detailed) classification system.

Thus, even if properly combinable, Ginter and Popolo do not teach or suggest the metal chemistry composition features recited in claims 21-23, 34, and 36.

F. Summary

For the foregoing reasons, the combination of Ginter and Popolo fails to teach or suggest all claimed limitations for all four independent claims 1, 19, 34, and 49. Accordingly, it is submitted that all claims are in condition for allowance. Additionally, the combination of Ginter and Popolo fails to teach or suggest the subject matter recited in dependent claims 10, 18, 21-23, 26, and 36. Thus, these claims are in condition for allowance for this additional, independent reason.

CONCLUSION

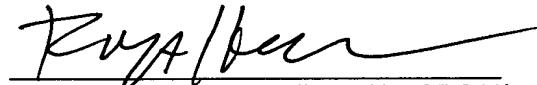
In view of the foregoing, reconsideration and withdrawal of the rejection and allowance of all pending claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

September 6, 2006



Roger A. Heppermann (Reg. No. 37,641)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
Telephone: (312) 474-6300